

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Office Action dated July 18, 2008. Reconsideration and allowance of the application in view of the remarks to follow are respectfully requested.

Claims 1-23 are pending in the Application. Claims 1, 9, 10 and 18 are independent claims.

In the Office Action, claims 1, 3, 4, 6-13, 15, 16 and 18-23 are maintained as rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,676,284 to Willson (Willson) in view of U.S. Patent Publication No. 2004/0179000 to Fermgard (Fermgard). Claims 5, 14 and 17 are maintained rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Willson in view of Fermgard in further view of U.S. Patent No. 6,801,276 to Epstein ("Epstein"). These rejections are respectfully traversed. It is respectfully submitted that claims 1-23 are allowable over Willson in view of Fermgard alone and in view of Epstein for at least the following reasons.

It is undisputed that Willson "lacks the teaching of the wires being protected from surroundings by a package of hot melt

material." (See, Office Action, page 2.) Yet the Office Action comes to the conclusion that (emphasis added) "Wilson modified by Fermgard is capable of meeting the claimed limitation" of "the wires being environmentally protected from exposure to the surroundings." (See, Office Action, page 3, 2nd paragraph.)

It is respectfully submitted that whether or not a combination of prior references is capable of fulfilling a stated claim recitation is not sufficient to render the claim limitation obvious in light of the prior art.

The Office Action takes a position that (emphasis in original) "since Fermgard teaches fixing an LED to a base 5 such that the 'LED is fixed by means of hot melt adhesive', the LED and its wires would have to be protected from damage caused by exposure with the environment since the LED is fixed with a hot melt material."

This position is respectfully traversed. It is respectfully submitted that the simple act of fixing the LED with hot melt material does disclose or suggest that "the LED mounting and electric contacts to the connection wires are environmentally protected ..." as recited in the claims.

Since it is undisputed that all Fermgard shows is fixing the LED to the base, then the statement that (emphasis added) "the LED and its wires would have to be protected from damage caused by exposure", would seem to be an argument that protection from exposure to surroundings is a necessary result of fixing the LED to the base. This position is respectfully refuted. It is respectfully submitted that neither of Wilson or Fermgard recognized that a package of hot melt material may be used to environmentally protect the LED mounting and the electrical contact wires.

The Office Action states that the rejection is based on the features of environment protection being obvious to one of ordinary skill in the art, however, the Office Action does not seem able to point to a single prior art reference that supports this premise.

It is respectfully submitted that this suggestion may only be construed from the hindsight gained from what is taught by the present patent application, since it clearly does not come from either of Willson or Fermgard.

It is respectfully submitted that how can the Office Action espouse that the reconstruction forwarded does not include

knowledge gleamed only from the Applicants' disclosure when in the fact, the cited references are silent as to use of a hot melt package for environmental protection. If this reconstruction did not come from the present application, where did it come from?

In consideration of the use of improper hindsight for rendering a claim obvious in light of prior art, the Federal Circuit has stated that "to draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction - an illogical and inappropriate process by which to determine patentability." (Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 38 USPQ2d 1551 (Fed. Cir. 1996)). "To imbue one of ordinary skill in the art with knowledge of the invention ensued, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." (In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997)).

"A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of

invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field (cited reference omitted). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher (cited references omitted).'" (In re Kotzab, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000)).

Since it is clear that Willson and Fermgard due not show this recitation of the claims, it is respectfully submitted that the assembly of claim 1 is not anticipated or made obvious by the teachings of Wilson in view of Fermgard. For example, Wilson in view of Fermgard does not disclose or suggest or inherently show for that matter, an assembly that amongst other patentable elements, comprises (illustrative emphasis added) "LED mounting and electric contacts to the connection wires are environmentally protected from exposure to the surroundings by a package of hot melt material" as recited in claim 1, and as similarly recited in each of claims 9, 10 and 18. Epstein is introduced for allegedly

showing elements of the dependent claims and as such, do nothing to cure the deficiencies in Wilson in view of Fermgard.

Accordingly, at least for these reasons, independent claims 1, 9, 10 and 18 are believed to be patentable over Wilson in view of Fermgard.

Claims 2-8, 11-17 and 19-23 respectively depend from one of claims 1, 10 and 18 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of the claims.

For example, in regard to the limitations of claims 2, 9, 19 and 21, the Office Action takes a position that (emphasis added) "'configures to' and 'capable of' are functional limitations and the applicant is advised that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations Ex Parte Masham, 2 USPQ F.2d 1647 (1987)." While the statement that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus, may be a true statement of the law, it is

respectfully submitted that it has little to do with the claims presented.

As made clear by the MPEP §2111.04 while terms such as "adapted to" "may raise a question as to the limiting effect of the language in a claim", "[t]he determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.*

Accordingly, the usage in the claim must be looked at to determine whether a recitation is a limitation in the claims or merely a statement of an intended use.

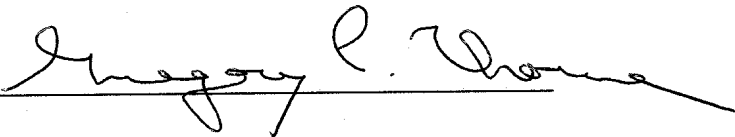
Claim 2 recites in pertinent part that "the hot melt material of the assembly is configured to stop ingress of dust penetration ...". It is not understood how this is interpreted merely as a statement of an intended use. The claim recites a particular configuration of the hot melt material which clearly is a structural recitation and therefore is not a mere statement of an

intended use. Claims 9, 19 and 21 have similar structural recitations and as such, should be similarly interpreted. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

By 

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